

**UNITED STATES DISTRICT COURT  
SOUTHERN DISTRICT OF NEW YORK**

**MERCK EPROVA AG and  
MERCK KGaA**

**Plaintiffs,**

**-vs.-**

**PROTHERA, INC.,**

**Defendant.**

**08 CV 00035 (RMB)**

**REPLY TO COUNTERCLAIM**

**ECF FILED**

Plaintiffs/Counterclaim-Defendants Merck Eprova AG (“Merck Eprova”) and Merck KGaA (collectively “Merck” or “Plaintiffs”), by and through their undersigned attorneys, as and for their Reply to the Counterclaim of ProThera, Inc. (“ProThera”), answer as follows:

**COUNTERCLAIM: DECLARATORY JUDGMENT**

**THE PARTIES**

120. Merck lacks sufficient knowledge or information to form a belief as to the truth of the allegations of Paragraph 120, and therefore denies the same.

121. Merck admits the allegations of Paragraph 121.

**REQUEST FOR DECLARATORY JUDGMENT**

122. Merck admits that it has sued ProThera for its knowing and willful false and misleading labeling of its product. ProThera’s actions constitute false advertising in violation of Section 43(a)(1)(B) of the Lanham Act, 15 U.S.C. § 1125(a)(1)(B); contributory false advertising in violation of Section 43(a)(1)(B) of the Lanham Act, 15 U.S.C. § 1125(a)(1)(B); contributory federal trademark infringement in violation of

Section 32(1) of the Lanham Act, 15 U.S.C. § 1114(1); trademark dilution in violation of Section 43(c) of the Federal Dilution Act of 1995, 15 U.S.C. § 1125(c); federal unfair competition in violation of Section 43(a)(1)(A) of the Lanham Act, 15 U.S.C. § 1125(a)(1)(A); unfair competition in violation of New York common law; trademark dilution in violation of N.Y. Gen. Bus. Law § 360(l); deceptive trade practices in violation of N.Y. Gen. Bus. Law § 349(h); and false advertising in violation of N.Y. Gen. Bus. Law § 350(e)(3). Merck denies the remaining allegations of Paragraph 122.

123. Merck admits the allegations of Paragraph 123.

124. Merck admits that ProThera has denied that it has engaged in any wrongful conduct in Paragraphs 58 through 117 of its Answer. Merck denies the remaining allegations of Paragraph 124.

125. Merck admits that one of the meanings of “genuine” is “real.” Merck denies the remaining allegations of Paragraph 125.

126. Merck admits that the dietary ingredient N-[4-[(2-amino-5,6,7,8-tetrahydro-4-hydroxy-5-methyl-(6S)-pteridiny]methyl]amino]benzoyl]-L-glutamic acid, calcium salt, is called L-5-methyltetrahydrofolic acid, calcium salt, which is abbreviated as “L-5-MTHF.” Merck denies the remaining allegations of Paragraph 126.

127. Merck admits that L-5-MTHF is used to describe the pure diastereoisomeric L-form of the compound 5-methyltetrahydrofolic acid, which is the biologically active form of folate. Merck denies the remaining allegations of Paragraph 127.

128. Merck denies the allegations of Paragraph 128.

129. Merck denies the allegations of Paragraph 129.

- 130. Merck denies the allegations of Paragraph 130.
- 131. Merck denies the allegations of Paragraph 131.
- 132. Merck denies the allegations of Paragraph 132.
- 133. Merck denies the allegations of Paragraph 133.
- 134. Merck denies the allegations of Paragraph 134.
- 135. Merck denies the allegations of Paragraph 135.
- 136. Merck denies the allegations of Paragraph 136.
- 137. Merck denies the allegations of Paragraph 137.
- 138. Merck denies the allegations of Paragraph 138.
- 139. Merck denies the allegations of Paragraph 139.
- 140. Merck denies the allegations of Paragraph 140.
- 141. Merck denies the allegations of Paragraph 141.
- 142. (a) Merck denies the allegations of Paragraph 142.
- 143. (a) Merck denies the allegations of Paragraph 143.
- 142. (b) Merck denies the allegations of Paragraph 142.<sup>1</sup>
- 143. (b) Merck denies the allegations of Paragraph 143.<sup>2</sup>
- 144. Merck denies the allegations of Paragraph 144.
- 145. Merck denies the allegations of Paragraph 145.
- 146. Merck denies the allegations of Paragraph 146.
- 147. Merck denies the allegations of Paragraph 147.
- 148. Merck denies the allegations of Paragraph 148.
- 149. Merck denies the allegations of Paragraph 149.

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<sup>1</sup> ProThera's Counterclaim has two paragraphs identified as number 142.

<sup>2</sup> ProThera's Counterclaim has two paragraphs identified as number 143.

150. Merck denies the allegations of Paragraph 150.

151. Merck denies the allegations of Paragraph 151.

**AFFIRMATIVE DEFENSES**

**FIRST AFFIRMATIVE DEFENSE**

The Counterclaim fails to state a cause of action upon which relief can be granted.

**SECOND AFFIRMATIVE DEFENSE**

Merck reserves the right to amend its answers to assert additional affirmative defenses that discovery may show exist.

Dated: March 26, 2008

New York, New York

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